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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,664	12/20/2001	Stuart J. Solomon	12587-022001 / 01316-00/U	1128
26212	7590	03/18/2004	EXAMINER BORISSOV, IGOR N	
FISH & RICHARDSON P.C. 225 FRANKLIN STREET BOSTON, MA 02110			ART UNIT 3629	PAPER NUMBER

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/027,664

Applicant(s)

SOLOMON ET AL.

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (US 2002/0169664).**

Walker et al. (Hereinafter Walker) teaches a method and system for providing offers using a billing statement, comprising:

**Claims 1, 6, 11, 16, 21 and 26.** Receiving at least one business transaction [0192]; determining whether the business transaction satisfies at least one configurable business rule [0192]; establishing a subsequent business transaction based on the results [0192]; [0155]; [0157].

**Claims 2, 7, 12, 17, 22 and 27.** Said method and system, wherein the configurable business rule specifies a relationship between the received business transaction and the subsequent business transaction [0192]; [0155]; [0157].

**Claims 3, 8, 13, 18, 23 and 28.** Said method and system, wherein the configurable business rule is configured based on at least one of a jurisdiction associated with the received business transaction, a time relationship between the received business transaction and a subsequent business transaction, and a business event associated with the received business transaction [0162].

**Claims 4, 9, 14, 19 and 24.** Processing business transactions having different formats [0048].

**Claims 5, 10, 15, 20 and 25.** Rejecting a requested transaction if this transaction does not satisfy business rules [0093].

Also,

**Claims 1, 6, 11, 16, 21 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Miksovsky et al. (US 5,918,216).**

Miksovsky et al. (Hereinafter Miksovsky) teaches a method and system for automatic recognition of periods for financial transactions, comprising:

**Claims 1, 6, 11, 16, 21 and 26.** Receiving at least one business transaction (column 3, lines 13-15); determining whether the business transaction satisfies at least one configurable business rule (column 2, lines 15-24); establishing a subsequent business transaction based on the results (column 2, lines 24-29).

**Claims 2, 7, 12, 17, 22 and 27.** Said method and system, wherein the configurable business rule (logic) specifies a relationship between the received business transaction and the subsequent business transaction (column 2, lines 15-29).

**Claims 3, 8, 13, 18, 23 and 28.** Said method and system, wherein the configurable business rule (logic) is configured based on at least one of a jurisdiction associated with the received business transaction, a time relationship between the received business transaction and a subsequent business transaction, and a business event associated with the received business transaction (column 7, lines 10-17).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4-5, 9-10, 14-15, 19-20 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miksovsky in view of Walker.**

**Claims 4, 9, 14, 19 and 24.** Miksovsky teaches all the limitations of **claims 4, 9, 14, 19 and 24**, except specifically teaching that processed business transactions have different formats.

Walker teaches said method and system for providing offers using a billing statement, wherein processed data can be of different formats [0048].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Miksovsky to include that processed business transactions have different formats, because it would enhance the versatility of the system, thereby make it more attractive to users.

**Claims 5, 10, 15, 20 and 25.** Walker teaches said method and system, wherein a controller (200) rejects a requested transaction if this transaction does not satisfy business rules [0093].

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks  
Washington D.C. 20231***

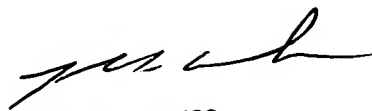
or faxed to:

Art Unit: 3629

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

IB



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
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